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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,433	04/20/2001	Claude Jarkae Jensen	10209.56	1737
21999	7590	04/04/2003		
KIRTON AND MCCONKIE 1800 EAGLE GATE TOWER 60 EAST SOUTH TEMPLE P O BOX 45120 SALT LAKE CITY, UT 84145-0120			EXAMINER	
			GOLLAMUDI, SHARMILA S	
		ART UNIT	PAPER NUMBER	
		1616		12
DATE MAILED: 04/04/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application N .	Applicant(s)
	09/839,433	JENSEN ET AL.
	Examiner	Art Unit
	Sharmila S. Gollamudi	1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 02 January 2003 .

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1, 7-8, 11-12, 22, and 27 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1,7,8,11,12,22 and 27 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_ .
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) <input type="checkbox"/> Other: _____ .

## DETAILED ACTION

Receipt for Request for Continued Examination and Amendment C received on January 2, 2003 is acknowledged. Claims 1, 7-8, 11-12, 22, and 27 are included in the prosecution of this application.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 7-8, 11-12, 22, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tahitian Noni Products (<http://www.noni-now.com>, copyright 1998-2003) in view of Pelle et al (6,136,301).**

Tahitian Noni teaches noni products and teaches the noni juice to deliver soothing and renewing benefits to the skin. The reference teaches the use of the oil contains linoleic acid and essential fatty acids to nourish the skin and dry spots (Note Tahitian Noni essential oil). The reference teaches a lip balm containing noni. Lastly, the reference teaches the combination of the juice and oil in Tahitian Noni Skin Supplement and Body Balance Cream.

The reference does specify percentages in the topical formulation.

Pelle et al teach a natural lip product for repairing chapped, cracked lips (col. 1, lines 10-25). Pelle teaches the use of free fatty acids (5-40%) such as oleic and palmitic acid since these are the primary naturally occurring free fatty acids in the stratum

corneum (col. 3, lines 40-56). A wax base "known in the art" is formulated from waxes and oils. Waxes such as beeswax, ozokerite or paraffin and plant or animal oils are taught in the amount of 1-20% (col. 4, lines 38-41). Pelle teaches the use of active agents such as antiirritants in the composition (col. 5, line 17).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tahitian Noni Products and Pelle et al. One would be motivated to look at Pelle et al since Pelle provides the general guidance in formulating a lip product. Further motivation to do so with the expectation of similar results being that Tahitian Noni products teaches noni to heal, sooth, and nourish the skin and the oil contains fatty acids and Pelle teaches a natural lip product containing conventional additives and free fatty acids from a natural source to heal the lips.

Although the Noni products fail to disclose the amount of the *morinda citrifolia* juice and oil, the mere difference in concentration as the sole criteria for patentability for subject matter encompassed by the prior art is not supported in the absence of unexpected data. See MPEP 2144.05.

**Claims 1 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonte et al (5, 676, 949) in view of Wadsworth et al (WO 01/15537) in further view of Fisher (Living Better, vol. 1 (5)).**

Bonte et al teach a cosmetic or pharmaceutical product for dermatological conditions. The composition is used to treat skin disorders such as hyperpigmentation, vitiligo, psoriasis, restoring/preserving the skin, and increasing moisture (col. 1, lines 15-

30). The composition contains .001-5% of a mulberry extract (examples and col. 3, lines 27-30).

Bonte does not teach specify the type of mulberry extract.

Wadsworth et al teaches morinda citrifolia oil, which can be used in cosmetics (col. 3, line 42). The reference discloses that morinda citrifolia is an essential oil that contains several different fatty acids (col. 3, lines 35-55 and Table 1).

Fisher teaches that French Polynesian used the juice for various ailments such as skin problems (abscesses, abrasions, wounds, infections, and boils).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use morinda citrifolia oil and juice in Bonte's cosmetic composition with the expectation of similar results since Bonte's teaches a generic mulberry extract. One would be motivated to use morinda citrifolia is that Wadsworth teaches the instant oil contains essential fatty acids, known for their conditioning properties and Fisher teaches the use of the instant plant extracts for its wound healing properties. Therefore, the instant mulberry extract would satisfy Bonte's functional properties such as treating skin disorders and increasing moisture in the skin. Further it is *prima facie* obvious to combine each of which is taught by the prior art to be useful for the same purpose, to form a third composition for the very same purpose.

\*Note that the preamble does not hold patentable weight unless a structural limitation is recited.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is (703) 305-2147. The examiner can normally be reached on M-F (7:30-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees can be reached on (703) 308-4628. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

SSG

April 2, 2003

*M. G. Hartley*  
MICHAEL G. HARTLEY  
PRIMARY EXAMINER